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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,249	03/13/2001	Masaaki Mori	1095.1171/JDH	9135
21171	7590	05/18/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			KLINGER, SCOTT M	
			ART UNIT	PAPER NUMBER
			2153	

DATE MAILED: 05/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/804,249

Applicant(s)

MORI ET AL.

Examiner

Scott M. Klinger

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-13 are pending.

Claims 7-13 are new.

Response to Arguments

Applicant's arguments, with respect to the rejection of claim 2 under 35 USC 102(e) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Suzuki

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8 and 11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims state that "*the predetermined server is determined based upon information included in a header*", if the server is determined by using header information, then it has not been predetermined. The term "*predetermined*" makes it unclear as to when the server is determined.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnold (U.S. Patent Number 6,275,848, hereinafter "Arnold") in view of Suzuki (U.S. Patent Number 5,440,551, hereinafter "Suzuki"). Arnold discloses method and apparatus for automated referencing of electronic information.

In referring to claims 1, 5, 6, 7, 10, and 13, Arnold shows substantial features of the claimed invention, including:

- Attached file separating step/means for separating, in the case of an attached file being added to electronic mail sent from the sender, the attached file from the electronic mail:
Arnold, Figure 2, element 210 shows the step of detaching the attachment from the mail item (which inherently implies an attached file separating means)
- Attached file transferring step/means for transferring the attached file separated from the electronic mail by the attached file separating means to a predetermined server:
Arnold, Figure 2, element 212 shows the step of storing the attachment on a remote site (which inherently implies an attached file transferring means)
- Store location information adding step/means for adding store location information indicating a location where the attached file transferred by the attached file transferring means is stored to the electronic mail:
Arnold, Figure 2, element 214 shows the step of substituting the attachment with a pointer (which inherently implies a store location information adding means)

However, Arnold does not show a transfer method setting means for setting a transfer method used by the attached file transferring means according to the attribute of an attached file. Nonetheless this feature is well known in the art and would have been an obvious modification of the system disclosed by Arnold as evidenced by Suzuki.

In analogous art, Suzuki discloses a multimedia packet communication system. Suzuki shows a system that changes the network transfer method based on the type of data to be transmitted (Suzuki, Fig. 2)

Given these teachings, a person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Arnold so as to set a transmission method

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based on the type of data that needs to be sent, such as taught by Suzuki, in order to low loss for streaming media and short setup delay for small files.

In referring to claim 3, Arnold in view of Suzuki shows,

- Not only store location information but also transfer method information indicating a transfer method used by the attached file transferring means are added to the electronic mail:

“(5) placing the attachment on a remote site; and (6) inserting a pointer into the message, wherein the pointer is linked to the remote site.” (Arnold, col. 2, lines 36-38)

A system that appends a pointer, which allows the user to retrieve the e-mail attachment, inherently implies the pointer includes the transfer method for retrieving said file

In referring to claim 4, Arnold in view of Suzuki shows,

- The attached file separating means, attached file transferring means, and store location information adding means are implemented as exit programs on an electronic mail server: Arnold, Figure 2 shows the attached file separating means, attached file transferring means, and store location information adding means are implemented as exit programs on an electronic mail server.

In referring to claims 8 and 11, although Arnold in view of Suzuki shows substantial features of the claimed invention, Arnold in view of Suzuki does not explicitly show how the server is chosen. Arnold in view of Suzuki does not explicitly show choosing a server based on the header of the electronic mail. Nonetheless this feature is well known in the art and would have been an obvious modification to the system disclosed by Arnold in view of Suzuk.

A person of ordinary skill in the art would have readily recognized the desirability and advantages of modifying the system of Arnold in view of Suzuki so as to chose the same server every time a specific recipient is to receive an email in order to consolidate all of a recipients attachments and facilitate easier access to them.

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In referring to claims 9 and 12, Arnold in view of Suzuki shows,

- The store location information corresponds to a store server, a store directory, a login account and a password to allow a receiver of the electronic mail to retrieve the attachment:

"Another technical advantage is that the invention manages access to a remotely located attachment through use of an attachment access list. Only those individuals or entities named on the access list may have access to the attachment. Preferably only the recipients of the e-mail message are listed on the access list." (Arnold, col. 2, lines 56-61)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Scott M. Klinger whose telephone number is (571) 272-3955. The examiner can normally be reached on M-F 9:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Scott M. Klinger
Examiner
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